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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/672,370

09/25/2003

Laurence E. Dahners

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EXAMINER

BOLES, SAMEH RAAFAT

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

06/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/672,370	Applicant(s) DAHNNERS, LAURENCE E.	
	Examiner SAMEH BOLES	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) 27-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/5/08, 8/2/06, 3/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

According to the Amendment filed on October 22, 2009, claims 1, 5-6, 21, 23 have been amended; claims 7-20 have been cancelled; claims 27-36 have been added, and claims 1-6, 21-36 are pending.

Election/Restrictions

1. Newly submitted claims 27-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claims 27-36 draw to a method of treating a fracture bone using an intrafocal plate, wherein the method of claims 27-36 can be practiced by using a different materially or a different design plate than the plate claimed in claims 1-6 and 21-26. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of the claimed invention. The independent claims 1, 5 and 6 contain a new subject matter of “said intrafocal plate **consisting of**”, wherein the specification of the current application teaches that the intrafocal plate **comprising**

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

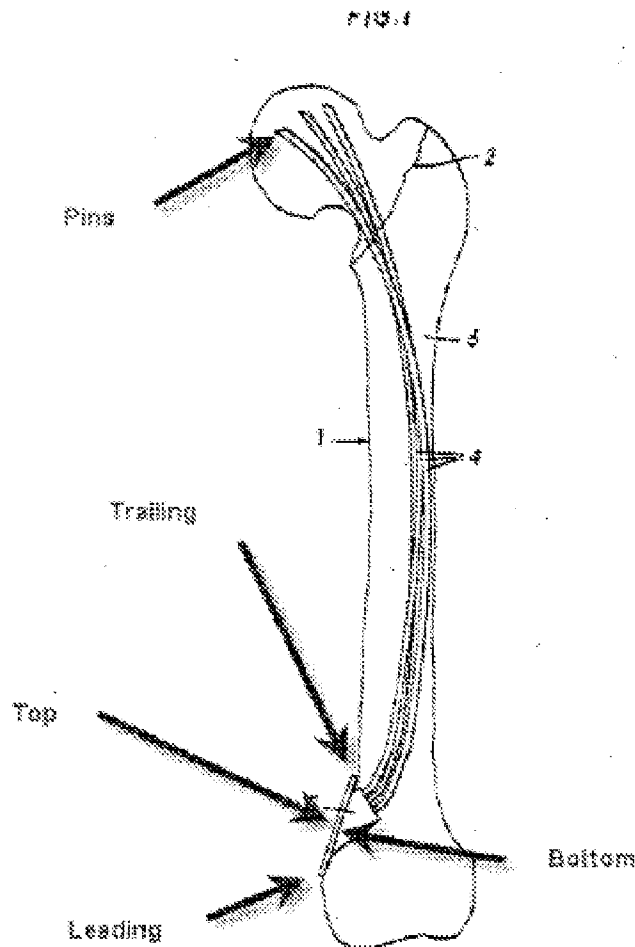
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1- 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ender (US Patent 4,467,793).

Ender discloses a longitudinally extending plate (5) made of resilient material consisting of a flat, elongated plate element (7, Fig. 2) having a surface at one end having a top and bottom and leading and trailing end that is sized to overlay a fracture site, and further has a longitudinally extending body element integral with the plate element and is further considered adjacent but spaced apart from the trailing end of the surface of the plate element and has apertures (6). The overhanging heel portion is adjacent to the trailing end and extends downwardly below the location at which the resilient body element is integral to the surface of the plate element. The heel serves to assist stabilize the fracture site. It is capable of preventing over-reduction. The intrafocal plate also has a body element (4) which extends down and outward from the bottom of the surface (see drawing below) and further has a pin element (see drawing below). The body element connects at a location that is between the leading end and trailing end.

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The intrafocal plate further has a shoulder at the juncture of the body element and surface and further defines an acute angle (adjacent to the trailing end portion in the drawing below). The plate including a screw for insertion through an aperture (9, Fig. 2 and 3) defined in the surface of the plate element (col. 5, lines 25-29).



Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ender (US Patent 4,467,793) in view of Harris (US. Pat. No. 4135507 A).

Ender teach the claimed invention except that the resilient body element has a first portion, a second portion and a third portion, wherein the first portion curves away from the plate element, the second portion curves toward the plate element and the third portion curves away from the plate element.

Harris teaches a resilient body element has an S-shape (Fig. 4, abstract), wherein the S-shape including a first curved portion, a second curved portion and a third curved portion.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify the resilient body element of Ender with a S-shape with three curved portions in view of Harris for facilitating insertion of the body element into bone or fractured site.

Ender in view of Harris failed to teach a fourth curved portion.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the resilient body element of Ender in view of Harris to have a fourth curved portion, since it has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments filed 1-6 have been fully considered but they are not persuasive.

Applicant argues that the intrafocal plate as recited in claims 1 and 6 is not disclosed, taught, suggested by or inherent in Ender because Ender includes a tubular insert member. The insert member is not flat on the side that faces bone and from which the nails will extend, because it needs the tubular portion for insertion into the impact hole as recited in Ender.

Examiner respectfully disagrees, since Ender teach a flange (7) (may be considered as a plate), wherein the flange is flat (Fig. 2) on the side that faces bone (Fig. 1) and from which the nails (4) will extend.

Applicant further argues that Ender failed to teach at least two screws extend through the flat plate element.

Examiner respectfully disagrees, since Ender teaches at least two screws for insertion through aperture (9, Fig. 2 and 3) defined in the flat surface of the plate element (col. 5, lines 25-29).

Applicant's arguments with respect to claims 21-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMEH BOLES whose telephone number is (571)270-5537. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SAMEH BOLES/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775